

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re: Patent Application of Charles Eldering et al.

Conf. No.: 2970 : Group Art Unit: 3622
Appln. No.: 09/591,577 : Examiner: Yehdega Retta
Filing Date: 09 JUNE 2000 : Attorney Docket No.: T702-03
Title: Privacy Protected Advertising Systems

APPLICANT'S COMMENTS ON STATEMENT OF REASONS FOR

ALLOWANCE UNDER 37 CFR 1.104(e)

Responsive to the Examiner's Statement of the Reasons for Allowance, included with the Notice of Allowance dated January 18, 2011, and concurrent with payment of the Issue Fee in the above-identified patent application, please consider the following remarks:

REMARKS

The following Remarks are made with respect to the Examiner's Statement of Reasons for Allowance ("Statement"), at pages 2 – 3 of the Notice of Allowability.

Rule 1.104(e) and MPEP 1302.14 permit the Examiner to set forth a written statement of reasons for allowance under certain circumstances. In particular, certain requirements for the statement of reason(s) are expressly set forth in MPEP 1302.14, including the requirement that, "each statement should include at least (1) the major difference in the claims not found in the prior art of record, and (2) the reasons why that difference is considered to define patentability over the prior art if either of these reasons for allowance is not clear in the record." The Statement with respect to all of the claims is traversed at least on the ground that it fails to comply with the aforesaid requirement of MPEP 1302.14. While the Statement may identify claimed features or elements that the Examiner considers to be the major difference that are not found in the prior art of record, the Examiner's Statement has not explained reasons why such differences are considered to define patentability over the prior art. That is, the Examiner's Statement does not provide any explanation other than repeating a portion of the independent claims. Thus, the Statement fails to satisfy express provisions of the MPEP.

Additionally, MPEP 1302.14 expressly provides that "the statement is not intended to necessarily state all the reasons for allowance or all the details why claims are allowed and should not be written to specifically or impliedly state that all the reasons for allowance are set forth." Applicant expressly reserves the right to assert in any future proceedings regarding this application or any patent(s) issuing directly or indirectly therefrom, the allowability and/or allowance of the claims on the basis of any reason(s) consistent with the prosecution history of the application. For example, in previous Office Action responses, as well as the Appeal Brief and the Reply Brief filed in the present application, Applicants have identified for the Examiner several other features as distinguishing the claims over the prior art. For Example, Applicants have previously discussed that U.S. Patent No. 6,463,585 to Hendricks does not teach or suggest pre-defined heuristic rules at all – not simply the heuristic rules as articulated by the

Examiner in the Statement. Accordingly, although not specifically noted by the Examiner in the Statement, Applicants respectfully note that such features -- either independently or in combination -- also might form the basis for allowance of the present claims.

For the foregoing reasons, Applicants therefore deny acquiescence to such Statement and further deny being bound by any presumption or negative inferences that may flow therefrom in any future proceedings regarding this application or any patent(s) issuing directly or indirectly therefrom.

Respectfully submitted,

Date: 4/18/11

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